



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,405	01/05/2005	Johann Bonn	263493US0PCT	9920
22850	7590	06/25/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1712	PAPER NUMBER
			NOTIFICATION DATE 06/25/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/519,405	Applicant(s) BONN ET AL.	
	Examiner Daniel S. Metzmaier	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/5/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-15 are pending.

Response to Amendment

1. Applicants are required to provide a new claim listing in response to this Office

Action in accordance with the last paragraph of MPEP § 714 II C. (A), which states:

For any amendment being filed in response to a restriction or election of species requirement and any subsequent amendment, any claims, which are non-elected, must have the status identifier (withdrawn). Any non-elected claims which are being amended must have either the status identifier (withdrawn) or (withdrawn – currently amended) and the text of the non-elected claims must be presented with markings to indicate the changes. Any non-elected claims that are being canceled must have the status identifier (canceled). (Emphasis added).

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-10, in the reply filed on 26 April 2007 is acknowledged. The traversal is on the ground(s) that "no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups" and "it has not been shown that a burden exists in searching the claims of the four groups". This is not found persuasive because, as a case filed under 35 USC 371, the case follows unity of invention rules. The examiner provides the rule citations and supporting references to show lack of unity of invention. Applicants fail to address said basis for a holding of a lack of unity of invention.

Furthermore, "serious burden" can be further established by (i) separate classification, (ii) status, or (iii) field of search. Serious burden clearly exist based on the fact that the various groups including methods of using may have application in

some processes but not others. The methods are also separately classified in at least class 516 and class 162.

The examiner's burden for establishing restriction under 35 USC 121 and 372, PCT Rules 13.1 and 13.2 has been met. Applicants have failed to address the basis including the supporting evidence set forth in the restriction.

The requirement is still deemed proper and is therefore made FINAL. Claims 11-15 have withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 26 April 2007.

Priority

3. Receipt is acknowledged of papers received in this national stage application from the International Bureau (PCT Rule 17.2(a)), submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. A copy of reference AR, which a copy was not submitted, has been submitted for scanning. The US Pat equivalent has been cited on the PTO-892.

Oath/Declaration

5. It is noted that the Original declaration has the box checked that the application "was filed on" but lacks a date. Since the title in the declaration, the title on the specification filed, and the title on the transmittal letter correspond and the inventors are named in the declaration, said declaration is acceptable. See MPEP 602(VI).

Specification

6. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Henkel KgaA, DE 198 57 204 A, as evidenced by Millhoff et al, US 6,340,662. Millhoff et al is English language family equivalent to Henkel. See Table 1.

9. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Asahi Denka Kogyo KK, JP 2000-230084 A, as evidenced by Derwent Abstract AN 2000-631444, and the Machine Translation based on JP 2000-230084 A. Asahi Denka Kogyo KK (abstract) discloses the combination of fatty acid bis-amides (paragraph [0014] specifically mentions methylenebis octadecanamide) with polyglyceryl esters having 5 to 80 % esterification content. The polyolefin monomer resin compositions employing the bis-amide and polyglyceryl esters would inherently function as additives for antifoams and/or de-aerators as claimed.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1712

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel KgaA, DE 198 57 204 A, as evidenced by Millhoff et al, US 6,340,662. Millhoff et al is English language family equivalent to Henkel. See Table 1. The citations hereafter refer to the Millhoff et al '662, which is the same or substantially the disclosure as Henkel KgaA.

Henkel KgaA and Millhoff et al differ from claim 5 in the ratio of the polyglyceryl esters to bisamides of 3:1 to 1.5:1.

Henkel KgaA and Millhoff et al (claim 1) discloses the use of 2 to 15 % by weight of nonionic emulsifier. At 15 % by weight of polyglyceryl esters, the polyglyceryl ester to bisamide ratio of the example would be about 2.5 : 1.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to vary the concentrations of the polyglyceryl ester emulsifiers disclosed in the Henkel KgaA and Millhoff et al references for the advantage of providing a homogeneous dispersion of the defoaming agents in said dispersion at their point of use.

12. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavchok et al, US 4626,377, taken with Schuhmacher et al, US 5,700,351, or Wegner et al, US 5,236,499. Kavchok et al (column 3, lines 37-54; example and claims) discloses aqueous hydrophobic defoaming dispersions employing a fatty alcohol of 14-28 carbon atoms, a fatty acid, fatty soap, a nonionic surfactant and a secondary

Art Unit: 1712

hydrophobic solid dispersion in a water insoluble liquid including bisamides dispersed in mineral oil (example 4 and claims). Kavchok et al (column 1, lines 21 et seq) discusses foaming as a problem in a number of chemical industries including the pulp and paper industries.

Kavchok et al differs from the claims in the incorporation of a polyglyceryl ester into the compositions.

Schuhmacher et al and Wegner et al (title and abstract) disclose defoaming compositions for the paper industry in the form of oil-in-water emulsions employing fatty alcohols, hydrocarbons (e.g., oils), esters and polyglyceryl esters having at least 20% esterification of a polyglyceryl mixture.

These references are combinable because they teach aqueous dispersions as defoaming compositions for the paper industry. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of applicants' invention to employ the aqueous compositions of Schuhmacher et al and Wegner et al with those of Kavchok et al for the purpose of defoaming paper industry processes as a point of law.

It is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in *Kerkhoven* and *Crockett*, the idea of combining them flows logically from their having been individually taught in the prior art.

Furthermore, it would have been *prima facie* obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the art recognized secondary components as a dispersion of hydrophobic solid in a water insoluble liquid taught in the Kavchok et al reference for aqueous defoaming dispersions into the aqueous dispersions of Schuhmacher et al and Wegner et al for the defoaming properties of the dispersed hydrophobic solids.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-5 and 7-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claims 1, 5 and 8 of copending Application No. 10/570,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims

encompass the copending claims that further include finely divided, inert solids. The instant claimed employ open transitional language, e.g., "comprising". The instant claims are generic to and encompass the use of inert solids including cellulose. See the paragraph bridging pages 8 and 9 of the instant specification. Based on copending claim 8, the expectation is that the amides and esters are useful in all ratios. Copending claim 5 sets forth fatty alcohols

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pachai et al, US 6,251,958 and cited in the International SR, is cumulative or less pertinent than the above art relied on in the rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM